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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

ENGLAND, DAVID E

ART UNIT

PAPER NUMBER

2143

DATE MAILED: 11/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/882,109	ALTAVILLA ET AL.	
	Examiner	Art Unit	
	David E. England	2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3 - 5, 7, 9, 11, 15, 17 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3 - 5, 7, 9, 11, 15, 17 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. Claims 1, 3 – 5, 7, 9, 11, 15, 17 and 20 are presented for examination.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1, 3 – 5, 7, 9, 11, 15, 17 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukumoto et al. U.S Publication No. 2001/0051987 (hereinafter Fukumoto) in view of Rochkind U.S. Patent No. 6301608.**

4. As per claim 1, as closely interpreted by the Examiner, Fukumoto teaches a process for identifying an attention level in an electronic mail text message being sent to multiple recipients comprising:

5. creating a list of addresses for said recipients, (e.g., ¶ 0048 – 0052);
6. identifying a specific portion of said text message to be highlighted for a specific address, (e.g., ¶ 0048 – 0052);
7. a tag identifying said specific highlighted portion, (e.g., ¶ 0048 – 0052);
8. sending said text message to each of said recipients which includes each of said addresses and the appended tags, (e.g., ¶ 0061 – 0065); and

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9. displaying for each recipient said text message with an attention level indication in response to the tag associated with the recipients address and with said specific portion highlighted for said recipient having said specific address, (e.g., ¶ 0048 – 0052, 0071 – 0073). Fukumoto does not explicitly teach appending to each of said addresses a tag representing an attention level for said recipients. Rochkind teaches appending to each of said addresses a tag representing an attention level for said recipients, (e.g., col. 6, lines 12 – 40). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Rochkind with Fukumoto because correlating a specific recipient's address with a section of a email message to be highlighted for their specific attention will give a specific recipient the ability to pay attention and identify at a glance, the important parts of the email that pertain to that specific recipient.
10. As per claim 3, Fukumoto does not specifically teach selecting said attention level from a table displayed on a user's display screen;
11. selecting an address from a table containing said address list;
12. attaching a tag representing said attention level to said selected address.
13. Rochkind teaches selecting said attention level from a table displayed on a user's display screen, (e.g., col. 6, lines 12 – 40);
14. selecting an address from a table containing said address list, (e.g., col. 6, lines 12 – 40);
15. attaching a tag representing said attention level to said selected address, (e.g., col. 6, lines 12 – 40). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Rochkind with Fukumoto because of similar reasons stated above and

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furthermore it is well known in the art that utilizing a graphical user interface (GUI) is visually more convenient for a user to initiate commands as in a web page or Windows type system than a non-GUI system that would require specific commands to carry out tasks such as DOS or Unix.

16. As per claim 4, Fukumoto does not specifically teach attaching a tag representing a default attention level when an attention level is not specified for an address.

17. Rochkind teaches attaching a tag representing a default attention level when an attention level is not specified for an address, (e.g. col. 6, lines 33 – 46). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Rochkind with Fukumoto because it would be more convenient for a user to not have to always select an attention level if there is nothing to draw the user's attention to.

18. As per claim 5, Fukumoto does not specifically teach ordering each message to be displayed by a recipient according to said attention level. Rochkind teaches ordering each message to be displayed by a recipient according to said attention level, (e.g. Abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Rochkind with Fukumoto because it would be more efficient for a user to view the emails that are most important to them first then emails that are less important or have no importance at all.

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19. Referencing claim 20, as closely interpreted by the Examiner, Fukumoto teaches a process for identifying an attention level in an electronic mail test message being sent to multiple recipients comprising:

20. creating a list of addresses for said recipients, (e.g., ¶ 0048 – 0052);

21. identifying a specific portion of said text message to be highlighted for a specific address, (e.g., ¶ 0048 – 0052);

22. appending a tag2 identifying said specific highlighted portion, (e.g., ¶ 0048 – 0052, “... *the part matching the keyword, it designates the part as the part to be emphasized and highlighted for the corresponding receiver.*”);

23. sending said text message to each of said recipients which includes each of said addresses and the appended tag2 , (e.g., ¶ 0048 – 0052);

24. decoding tag2 with said specific portion highlighted for said recipient having said specific address, (e.g., ¶ 0048 – 0052),

25. wherein the displaying and the decoding are executed on electronic mail terminals of the recipients, (e.g., ¶ 0048 – 0052), but does not specifically teach to eat of said addresses a tag 1 representing an attention level for said recipients;

26. sending said text message to each of said recipients which includes each of said addresses and the appended tag1;

27. displaying for each recipient said text message with an attention level indicating in response to the tag1 associated with the recipients address.

28. Rochkind teaches to eat of said addresses a tag 1 representing an attention level for said recipients, (e.g., col. 6, lines 12 – 40, Table 2),

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29. sending said text message to each of said recipients which includes each of said addresses and the appended tag1, (e.g., col. 6, lines 12 – 40, Table 2);

30. displaying for each recipient said text message with an attention level indicating in response to the tag1 associated with the recipients address, (e.g., col. 6, lines 12 – 40, Table 2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Rochkind with Fukumoto because of similar reasons stated above.

31. Claims 7, 9, 11, 15 and 17 are rejected for similar reasons as stated above.

Response to Arguments

32. Applicant's arguments filed 12/27/2005 have been fully considered but they are not persuasive.

33. **In the Remarks**, Applicant argues in substance that Fukumoto does not disclose or teach appending to each of said addresses a tag representing an attention level for said recipients and a tag identifying said specific highlighted portion for each recipient.

34. As to the first Remark, Examiner would like to draw the Applicant's attention to the above rejection. In which one can see that Fukumoto was not relied upon for teaching said limitation, Rochkind was the indented reference. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

35. **In the Remarks**, Applicant argues in substance that the combination of Rochkind does not disclose “a tag identifying said specific highlighted portion,” as recited in claim 1.

36. As to the second Remark, Examiner would like to draw the Applicant’s attention to the rejection stated above, in which it is stated that Fukumoto more specifically teaches this limitation as seen in ¶ 0051 with regard to a key word that can be interpreted as a type of tag. Furthermore, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

37. **In the Remarks**, Applicant argues in substance that neither the teaching or suggestion to make the claimed combination are found in the prior art.

38. As to the third Remark, the Examiners motivation was paraphrased from the combine references that would be well known to any person that views something that is highlighted. The whole purpose of highlighting, even a writing highlighter, it to grab someone’s attention to a specific section of a document. Furthermore, as stated in Fukumoto in ¶ 0043, “*According to such an According to such an E-mail system, when a sender transmits broadcast E-mail, the part related to a receiver is automatically emphasized and displayed on the terminal of each receiver. Since the part related to the receiver is usually important to the receiver, the part is emphasized and displayed, so that the receiver can easily recognize the important part.*” It is

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very apparent that the prior art does have motivation to combine the references. It is also very apparent that there can be more than one section of motivation found in the prior art.

39. Furthermore, When reviewing a reference the applicants should remember that not only the specific teachings of a reference but also reasonable inferences which the artisan would have logically drawn therefrom may be properly evaluated in formulating a rejection. In re Preda, 401 F. 2d 825, 159 USPQ 342 (CCPA 1968) and In re Shepard, 319 F. 2d 194, 138 USPQ 148 (CCPA 1963). Skill in the art is presumed. In re Sovish, 769 F. 2d 738, 226 USPQ 771 (Fed. Cir. 1985). Furthermore, artisans must be presumed to know something about the art apart from what the references disclose. In re Jacoby, 309 F. 2d 513, 135 USPQ 317 (CCPA 1962). The conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference. In re Bozek, 416 F.2d 1385, 163 USPQ 545 (CCPA 1969). Every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein. In re Bode, 550 F. 2d 656, 193 USPQ 12 (CCPA 1977).

Conclusion

40. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E. England whose telephone number is 571-272-3912. The examiner can normally be reached on Mon-Thur, 7:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

David E. England
Examiner
Art Unit 2143

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JEFFREY PWU
PRIMARY EXAMINER